

REMARKS

The present application includes claims 1-5, 8-17 and 19-25 all of which were rejected. By this Amendment, claims 1, 9, 13, 22 and 23 have been amended. The Applicants respectfully submit that the pending claims define patentable subject matter.

Claims 1, 2, 4, 5 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,498,604 (“Jensen”) in view of JP 0116354 (“Iwase”). Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen, Iwase and U.S. 7,116,311 (“Martinez”). Claims 9, 11, 12 and 22-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen in view of U.S. 6,710,267 (“Natsuyama”) and Iwase. Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen, Natsuyama, Iwase and Martinez. Claims 13-17 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen in view of Iwase and U.S. 2005/0156952 (“Orner”). Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen, Iwase, Orner and U.S. 2002/0046071 (“Walker”). Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen, Iwase, Orner and Natsuyama. As shown, Jensen and Iwase form the basis for all the claim rejections. The Applicants respectfully traverse these claim rejections for at least the reasons previously set forth during prosecution and the following:

Claim 1 has been amended to clarify that “said rollerball and said bearing are each **formed of an anti-bacterial material.**” Claim 9 has been amended to clarify that “an entirety of said anti-bacterial rollerball assembly is **formed of an anti-bacterial material.**” Claim 13 has been amended to clarify “wherein an entirety of the pen-shaped input device is **formed of anti-bacterial material.**” Claim 22 has been amended to recite that “an entirety of the anti-

bacterial input device, including the anti-bacterial rollerball, is formed of an anti-bacterial material.”

I. The Proposed Combination Of Jensen And Iwase Does Not Render Claims 1, 2, 4, 5 And 8 Unpatentable

The Applicants first turn to the rejection of claims 1, 2, 4, 5 and 8 as being unpatentable over Jensen in view of Iwase. As noted above, Jensen and Iwase form the basis for all the claim rejections. In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (MPEP) states the following:

[T]he prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must **both be found in the prior art, and not based on applicant's disclosure.**

See Manual of Patent Examining Procedure (MPEP) at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Thus, as clearly set forth above, in order to establish a *prima facie* case of obviousness with respect to the claims, Jensen and Iwase must **teach or suggest all the claim limitations**. The Applicants respectfully submit, however, that the proposed combination of Jensen, Iwase and any other cited reference does not teach or suggest all the claim limitations.

As noted above, claim 1 recites, in part, “said rollerball and said bearing are each formed of an anti-bacterial material.” Claim 1 is clear that these components are “formed of an anti-bacterial material,” not just coated with such a material.

The Office Action acknowledges that “Jensen fails to teach that the main body, rollerball and bearing are formed of an anti-bacterial material or covered with an anti-bacterial coating.” See October 31, 2007 Office Action at page 3. In attempting to overcome this deficiency, the

Office Action relies on an English translation cover sheet for JP 0116354 ("Iwase") as disclosing an input device being formed of an anti-bacterial material. *See id.*, e.g., at page 3 ("Examiner cites Iwase to teach an input device formed of an anti-bacterial material (*See Abstract*)").

However, the Iwase cover sheet states an "Antibacterium type wiring tool such as a ball point pen, signing pen, sharp pen, brush pen and fountain pen – has main body and cap part made up of material which includes antibacterial agent." *See* Iwase cover sheet (provided to Applicants by Examiner). The cover sheet provides more detail by stating that the "wiring tool is constituted by a cap part (1) and a main body (2). **The outer surface of this main body and the cap part is made up of material which includes an antibacterial agent.**" *See id.* (emphasis added). Thus, the cover sheet of Iwase is clear that, while the main body and cap part are made up material that includes an anti-bacterial agent, it is only the outer surface of the main body and the cap part that include the anti-bacterial agent. *See id.* In short, Iwase appears to disclose that the main body and cap part are coated with the material, but not **formed** of the material.

Further, in relation to the Figures of Iwase, **only** the cap part 2 and the main body 1 are "made up of material which includes an antibacterial agent," such that the "outer surface of [the] main body and the cap part is made up material which includes an antibacterial agent." *See id.* The cover sheet of Iwase does not indicate that the ink delivery tube, tip or any other portion of the pen are made up of antibacterial agents, or even covered with such agents. Indeed, the Applicants respectfully submit that a ball point ink delivery system or other such system would not be formed of an anti-bacterial agent. For example, if the ink ball point of Iwase was covered with an anti-bacterial coating, ink that flowed around the ball point would most likely erode and

degrade such coating. Further, there is absolutely nothing in the cover sheet of Iwase that discloses that anything other than outer surfaces of the main body and cap part are covered with the antibacterial agent. The Applicants reiterate that the MPEP is clear that the “prior art reference (or references when combined) **must teach or suggest all the claim limitations.**” See MPEP at § 2142.

The Office Action has not shown that the proposed combination of Jensen, Iwase or any of the other cited references describe, teach or suggest “wherein said main body, said rollerball and said bearing are **each formed of an anti-bacterial material**,” as recited in claim 1, as amended. Thus, for at least this reason, the Office Action has not established a *prima facie* case of obviousness with respect to claims 1-5 and 8. Indeed, the Applicants respectfully submit that the proposed combination of references does not render claims 1-5 and 8 unpatentable.

The Office Action responds to the Applicants by stating the following:

[T]he Examiner used Iwase to teach that the concept of applying an antibacterial agent on a pen-type device is well known in the art. Furthermore, Iwase teaches that every surface of the pen device, except for the ink related surfaces, are covered by the antibacterial agent.

See October 31, 2007 Office Action at page 13.

The Applicants respectfully point out, however, that the cover sheet of Iwase does not describe, teach or suggest that “**every** surface of the pen device, except for the ink related surfaces, are covered by the antibacterial agent,” as asserted by the Office Action, nor has the Office Action shown that anything else in Iwase describes, teaches or suggests such a feature. Instead, as clearly demonstrated above, Iwase merely discloses that outer surfaces of just the main body and the cap part are covered by an antibacterial agent. See Iwase at cover sheet.

Further, the cover sheet of Iwase does not describe, teach or suggest that the main body and cap part are **formed** of the anti-bacterial agent. *See id.* Instead, as clearly recited in the cover sheet the “**outer surface** of this main body and the cap part is made up of material which includes an antibacterial agent.” Thus, for at least this reason, the Applicants respectfully request reconsideration of the claim rejections.

The Office Action also states the following:

In addition, the Examiner points out that Jensen is an input device that does not expel ink. Therefore, the Examiner has used the teachings of Iwase, that is, applying an antibacterial agent to pen-type surfaces that do not expel ink, to modify the input device taught by Jensen.

See October 31, 2007 Office Action at pages 13-14.

As noted above, however, Jensen and Iwase “**must teach or suggest all the claim limitations.**” *See* MPEP at § 2142. At best, the proposed combination of Jensen and Iwase teaches a device in which outer surfaces of only a cap part and main body are covered with, but not formed of, an antibacterial agent. Further, the proposed combination does not describe, teach or suggest that an **entirety** of a device is **formed** of an anti-bacterial agent. The Applicant respectfully points out that the relevant inquiry into a combination of references, such as Iwase and Jensen, is the references themselves, and not the Applicants’ claims in addition to the references. That is, in combining Jensen with Iwase, the resulting structure is confined to what is described in those references, and not the Applicants’ claims. Indeed, the MPEP is clear that the “**prior art reference (or references when combined) must teach or suggest all the claim limitations.**” *See* MPEP at § 2142. The Applicants respectfully submit that it is improper to rely on limitations recited in a claim to support a rejection (e.g., by supplying claim limitations not found in the cited

references, or providing a motivation to combine the references). Thus, for at least this reason, the Applicants respectfully request reconsideration of the claim rejections.

II. The Proposed Combination Of Jensen, Iwase And Other References Does Not Render The Remaining Claims Unpatentable

The Applicants next turn to the rejection of claims 9, 11, 12 and 22-25 as being unpatentable over the proposed combination of Jensen in view of Natsuyama and Iwase. For at least the reasons discussed above, the Applicants respectfully submit that this proposed combination of references does not describe, teach or suggest “an anti-bacterial rollerball assembly located at said distal operative end of said main body, wherein an entirety of said anti-bacterial rollerball assembly is formed of an anti-bacterial material,” or a “plurality of anti-bacterial lateral buttons positioned on said main body,” as recited in claim 9. Thus, for at least these reasons, the Applicants respectfully submit that the proposed combination of references does not render claims 9-12 unpatentable.

Additionally, as discussed above, the proposed combination of Jensen, Iwase or any of the other cited references does not describe, teach or suggest “wherein an entirety of the pen-shaped input device is formed of anti-bacterial material,” as recited in claim 13, as amended. Thus, the Applicants respectfully submit that the proposed combination of references does not render claims 13-17 and 19-21 unpatentable.

Further, as set forth above, the proposed combination of references also does not describe, teach or suggest “providing an anti-bacterial rollerball at a distal end of an anti-bacterial input device, wherein an entirety of the anti-bacterial input device, including the anti-bacterial rollerball, is formed of an anti-bacterial material,” as recited in claim 22, as amended.

Thus, for at least this reason, the proposed combination of references does not render claims 22-25 unpatentable.

III. Conclusion

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. The Applicants expressly reserve the right, however, to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney. While no fee is believed due with respect to this Amendment, the Commissioner is nonetheless authorized to charge any necessary fees, or credit any overpayment to Deposit Account 50-2401.

Respectfully submitted,

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